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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,367	02/17/2004	Anuj Jain	ORCL-2003-149-01	1849
51206 7590 05/14/2009 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER POPOVICI, DOV	
			ART UNIT 2625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/780,367	Applicant(s) JAIN, ANUJ	
	Examiner Dov Popovici	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because the form and legal phraseology often used in patent claims, such as "comprising" (found in the abstract on line 3) should be avoided. In the abstract, line 3, the recitation of "comprising" should be --includes--. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 10-11, 13, 17-18, 20 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by McAfee et al. (U.S. 2003/0206312 A1).

As to claim 1, McAfee et al. discloses a method for outputting information comprising: accessing information associated with an application accessible from a computer system (see figure 1, computer 102) located at a first location; requesting output of said information to an electronic device (local printer 120, remote printer 128); determining a location of said electronic device (see paragraph 0054); determining if said first location is remote to said location of said electronic device (see paragraph 0054); and if said first location is remote to said location of said electronic device, preventing output of said information to said electronic device (see paragraph 0045).

As to claim 2, McAfee et al. discloses wherein said electronic device is a printing device (120, 128) and said information represents an electronic representation of a document (see paragraphs 0045 and 0054).

As to claim 3, McAfee et al. discloses determining a default printer associated with said application; and if said default printer is remote to said first location, automatically modifying said default printer such that said default printer is local to said first location (see paragraphs 0044-0045 and 0054).

As to claim 4, McAfee et al. discloses wherein said preventing output comprises rendering a user alert (reads on: a window to pop up on the user's computer screen, the user is prompted to click a button to confirm remote printing) when said first location is remote to said location of said electronic device (see paragraph 0045).

As to claim 5, McAfee et al. discloses allowing output of said information to said electronic device in response to a user validation (reads on: user prompted to click button in the windows to confirm the remote printing) (see paragraph 0045).

As to claim 10, McAfee et al. discloses a system for detecting information output to a remote device (see figure 4, remote printer 28) comprising: a first electronic device (computer 102) in a first location and comprising information; an application accessible from said first electronic device (computer 102) and for requesting output of said information to a second electronic device (remote printer 28) in a second location; a location determiner (see figure 6, 112, 190) in communication with said first electronic device (computer 102) and for determining if said first location is remote to said second location (see paragraphs 0044 and 0054); and a data output request filter (see paragraphs 0044-0045) for filtering information output requests from said application if said first location is remote to said second location.

As to claim 11, McAfee et al. discloses wherein said second electronic device is a printing device (remote printer 28).

As to claim 13, McAfee et al. discloses a modifier for modifying default settings associated with said application based on said first location and said second location wherein said modifier automatically selects a local electronic device to receive output from said first electronic device (see paragraphs 0044-0045 and 0054).

As to claim 17, McAfee et al. discloses wherein said filter generates an alert when said second electronic device is remote to said first electronic device and temporarily suspends output to said second electronic device (see paragraph 0045).

As to claim 18, McAfee et al. discloses a method for printing (see figure 1) comprising: accessing a request to output a data file associated with an application accessible from a first electronic device (computer 102) situated at a first location; determining that said request targets a first printer (remote printer 128); determining a location associated with said first printer (see paragraph 0054); determining if said first location is remote to said location of said first printer (see paragraphs 0044-0045 and 0054); and filtering said request (reads on: the printer driver may cause a window to pop up on the user's computer screen to inform the user that the print job is going to be submitted to a remote printer. The user could also be prompted to click on a button in the window to confirm the remote printing process before the print job can be sent to the remote printer; i.e., first requiring confirmation from the user; see paragraph 0045)user if said first location is remote to said location of said first printer (see paragraph 0045).

As to claim 20, McAfee et al. discloses wherein said filtering comprises automatically modifying default print options of said first electronic device such that said request is routed to a second printer (local printer 120) local to said first location (see paragraphs 0044-0045 and 0054).

As to claim 23, McAfee et al. discloses generating an alert on said first electronic device when said first location is remote to said first printer and allowing said request to said first printer in response to a user validation (see paragraph 0045).

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 9, 12, 14, 15, 16, 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAfee et al. (U.S. 2003/0206312 A1).

As to claim **6**, McAfee et al. teaches that the confirmation feature can be disabled by the user (see paragraph 0045) and wherein said preventing output comprises rendering a user alert (see paragraph 0045).

McAfee et al. does not teach wherein said preventing output comprises disabling a graphical icon or menu option on said computer system that is associated with said electronic device.

The examiner is taking "Official Notice" that wherein said preventing output comprises disabling a graphical icon or menu option on said computer system that is associated with said electronic device (i.e., printer) is well known in the computer-printer technology.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. wherein said preventing output comprises disabling a graphical icon or menu option on said computer system that is associated with said electronic device.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. wherein said preventing output

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comprises disabling a graphical icon or menu option on said computer system that is associated with said electronic device, because of the following reason(s): (1) disabling a graphical icon or menu option on said computer is an alternative method for preventing output by altering the user to the remote printing process, this requires from the user the action to enable the graphical icon or menu option on the computer similarly as a confirmation feature, in order to confirm by the user and enable the user to print by the remote printing process; (2) disabling a graphical icon or menu option will prevent the accidental printing to the remote printer.

As to claim 7, McAfee et al. teaches determining said first location and said location of said electronic device (see paragraph 0054). McAfee et al. discloses the remote printer can be accessed via a location identifier in accordance with well known communication techniques.

McAfee et al. does not teach determining said first location and said location of said electronic device based on global positioning satellite (GPS) data.

The examiner takes "Official Notice" that determining a location and said location of said electronic device based on global positioning satellite (GPS) data is well known in the art.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. wherein said determining said first location and said location of said electronic device is based on global positioning satellite (GPS) data.

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. wherein said determining said first location and said location of said electronic device is based on global positioning satellite (GPS) data because of the following reason(s): (1) McAfee et al. indicates at paragraph 0054 that the remote printer can be accessed via a location identifier in accordance with well known communication techniques, and finding or determining a location based on GPS data is well known and commonly employed in today technology.

As to claim **9**, McAfee et al. teaches determining said first location and said location of said electronic device (see paragraph 0054). McAfee et al. discloses the remote printer can be accessed via a location identifier in accordance with well know communication techniques.

McAfee et al. does not teach determining said first location and said location of said electronic device from network topography data.

The examiner takes "Official Notice" that determining a location and said location of said electronic device from network topography data is well known in the art.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. wherein said determining said first location and said location of said electronic device from network topography data.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. wherein said determining said

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first location and said location of said electronic device from network topography data because of the following reason(s): (1) McAfee et al. indicates at paragraph 0054 that the remote printer can be accessed via a location identifier in accordance with well known communication techniques, and determining a location from network topography data is well known and commonly employed in today networking technology.

As to claim **12**, McAfee et al. teaches wherein said first electronic device (computer 102) comprises a display screen (see figures 3 and 5, 158) for displaying a print icon associated with said printing device. McAfee et al. does not specifically specify wherein said filter is also for disabling said print icon is disabled by said filter when said first location is remote to said second location.

The examiner is taking "Official Notice" that disabling a print icon is well known in the art.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. wherein said filter is also for disabling said print icon is disabled by said filter when said first location is remote to said second location.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. wherein said filter is also for disabling said print icon is disabled by said filter when said first location is remote to said second location, because of the following reason(s): (1) disabling a print icon on the computer is an alternative method for preventing output to a remote printer by altering the computer user to the remote printing request operation, this requires from the user

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an action to activate or enable the print icon on the computer screen similarly as a confirmation feature, in order to confirm by the user and enable the user to be able to print to a remote printing machine; (2) disabling a print icon will prevent the accidental printing of sensitive or important information to a remote printer, and will prevent accidental printing to a remote printer.

Claim **14** recites the same or similar claim limitation(s) as recited in claim 7.

Therefore, claim 14 is rejected similarly as claim 7. Applicant is directed to the remarks and the discussion made in claim 7 above.

Claim **15** recites the same or similar claim limitation(s) as recited in claim 9.

Therefore, claim 15 is rejected similarly as claim 9. Applicant is directed to the remarks and the discussion made in claim 9 above.

As to claim **16**, McAfee et al. teaches wherein the second electronic device (remote printer 28) is an electronic device.

McAfee et al. does not specifically specify that wherein the second electronic device is a portable electronic device.

The examiner is taking "Official Notice" that wherein the second electronic device is a portable electronic device is well known in the art.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. wherein the second electronic device is a portable electronic device.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. wherein the second electronic

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device is a portable electronic device because of the following reason(s): so that the electronic device can be carried or moved to other locations desired by the user, and, a portable electronic device will allow the user an advantage to easily carry and conveniently travel with the portable electronic device to any desired destinations by the user.

As to claim **19**, applicant is directed to the remarks and the discussion made in claims 6 and 12 above.

As to claim **21**, applicant is directed to the remarks and the discussion made in claims 7 and 14 above.

As to claim **22**, applicant is directed to the remarks and the discussion made in claims 9 and 15 above.

Claims **8** and **24** are rejected under 35 U.S.C. 103(a) as being unpatentable over McAfee et al. (U.S. 2003/0206312 A1) in view of Motegi (U.S. 6,307,640 B1).

As to claim **8**, McAfee et al. does not specifically specifies determining if said information is sensitive; and wherein said preventing output only prevents output if said information is sensitive.

Motegi teaches determining if said information is sensitive and wherein said preventing output only prevents output if said information is sensitive (see column 1, line 5 to column 2, line 15 and the abstract).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. by determining if said

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information is sensitive; and wherein said preventing output only prevents output if said information is sensitive.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified McAfee et al. by the teaching of Motegi to include determining if said information is sensitive; and wherein said preventing output only prevents output if said information is sensitive because of the following reason(s): (1) so as to prevent other individuals or users from viewing printed documents containing confidential, secure or sensitive information; and (2) for the reasons indicated and taught by Motegi at column 1, line 5 to column 2, line 15.

As to claim **24**, applicant is directed to the remarks and the discussion made in claim 8 above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Motegi (U.S. 6,307,640 B1).

As to claim 25, Motegi (U.S. 6,307,640 B1) discloses a method for preventing accidental output of information comprising: accessing information associated with an application accessible from a computer system (computer A-D, 101-104); requesting

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output of said information to an electronic device (printers A-D, 107-110); determining if said information is sensitive (see column 1, line 5 to column 2, line 15 and the abstract); and if said information is sensitive, preventing output of said information to said electronic device (see column 1, line 5 to column 2, line 15 and the abstract).

As to claim 26, Motegi (U.S. 6,307,640 B1) discloses wherein said preventing output comprises rendering a user alert (the host computer sends the job number to the terminal computer) when said information is sensitive (see column 1, line 5 to column 2, line 15 and the abstract and see figure 3).

As to claim 27, Motegi (U.S. 6,307,640 B1) discloses allowing output of said information to said electronic device in response to a user validation (i.e., user enters the user's password and job number).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Corlett et al. (U.S. 7,463,374 B2) teaches methods and apparatus for secure printing.

Takimoto (U.S. 6,202,092 B1) teaches print system managing the security of a printer shared on a network and security validating section.

Cherry et al. (U.S. 7,321,435 B2) teaches a system and method for authorizing printing services.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dov Popovici whose telephone number is 571-272-4083. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dov Popovici/
Primary Examiner, Art Unit 2625